

REMARKS

Reconsideration and allowance in view of the foregoing amendment and the following remarks are respectfully requested. Claims 1, 11 and 15 is/are amended.

Claim Objections

The Office Action objects to claims 11 and 15. Applicants have corrected the amendments to the claims and respectfully request withdrawal of this objection and entry of the claim amendments. Applicants note that the same amendments being made herein are those made in our August 18, 2006 filing. Although the Office Action notes that the amendments to the claims have been accepted, it also requires a correction. Accordingly, Applicants provide these amendments again that now conform to 37 CFR 1.121(c).

Rejection of Claims 1-5, 7-8, 11-12, 14-19, 21 and 22 Under 35 U.S.C. §103(a)

The Office Action rejects claims 1-5, 7-8, 11-12, 14-19, 21 and 22 under 35 U.S.C. §103(a) as being unpatentable over Rostoker et al. (U.S. Patent No. 6,035,212) ("Rostoker") in view of Dahm et al. (U.S. Patent No. 6,466,783) ("Dahm et al."). Applicants respectfully traverse this rejection and submit that one of skill in the art would not have sufficient motivation or suggestion to combine Rostoker et al. with Dahm et al.

To establish a *prima facie* case of obviousness, the Examiner must meet three criteria. First, there must be some motivation or suggestion, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to combine the references. Second, there must be a reasonable expectation of success, and finally, the prior art references must teach or suggest all the claim limitations. The Examiner bears the initial burden of providing some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must

present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." MPEP 2142.

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). MPEP 2143.01.

Furthermore, if the examiner determines there is factual support for rejecting the claimed invention under 35 U.S.C. 103, the examiner must then consider any evidence supporting the patentability of the claimed invention, such as any evidence in the specification or any other evidence submitted by the applicant. The ultimate determination of patentability is based on the entire record, by a preponderance of evidence, with due consideration to the persuasiveness of any arguments and any secondary evidence. *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). The legal standard of "a preponderance of evidence" requires the evidence to be more convincing than the evidence which is offered in opposition to it. With regard to rejections under 35 U.S.C. 103, the examiner must provide evidence which as a whole shows that the legal determination sought to be proved (i.e., the reference teachings establish a *prima facie* case of obviousness) is more probable than not. MPEP 2142.

The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art, and all teachings in the prior art must be considered to the extent that they are in analogous arts. Where the teachings of two or more prior art references conflict, the examiner must weigh the power of each reference to suggest solutions to one of ordinary skill in the art, considering the degree to which one reference might accurately discredit another. *In re Young*, 927 F.2d 588, 18 USPQ2d 1089 (Fed. Cir. 1991). MPEP 2143.01.

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

With these principles in mind, Applicants note that the Office Action on page 4 asserts that it would be obvious to one of skill in the art at the time of the invention to modify the wireless communication device that can “self adapt” to various communication protocols as taught by Rostoker et al. to include a visual interface for the mobile subscriber. Applicants respectfully traverse this analysis and note that when the suggestive power of each reference is objectively analyzed, it becomes clear that by a preponderance of the evidence one of skill in the art would certainly not incorporate a visual interface for the mobile subscriber as is taught in Dahm et al. into the teachings of Rostoker et al.

We first turn to the teachings of Rostoker et al. and immediately note that the wireless communication device taught by Rostoker et al. is introduced in the Abstract as configured to “self adapt to various operating frequencies”. This feature of self adaptation is important and is identified in numerous places as one of the fundamental objects of their invention. For example, in the last several paragraphs as Rostoker et al. introduce their invention, they note that it would be desirable to provide a cell phone which is not fully subject to operating frequency incompatibility issues. Rostoker et al. had introduced the issue of cell phones which may only be operable in one particular standard such as the CDMA standard but then move to a different area where another standard such as TDMA is available and thus rendering the cell phone unusable in such areas. Accordingly, they identify a need to provide a wireless communication device which self adapts to prevailing frequencies in cell phone service areas and one in which can operate in at least two service areas differing from one another in their protocol. Accordingly, the entire invention of Rostoker et al. is defined as addressing this issue and wherein a need is identified

for equipment that can be transported between two service areas that would continue to be operable in each one and in both of the service areas that “the change and equipment operation is transparent or not noticeable to the user.” Column 4, lines 23-40. Accordingly, in order to address these deficiencies, Rostoker et al. introduce their Summary of the Invention which includes a feature that it is “self-adaptable”. Rostoker et al. further identify an object of their invention is to provide the wireless communication device that “self adapts to certain frequencies and/or protocols and which may be adopted in locations to which the equipment may be transported and which performs this sales adaptation transparently to the user (i.e., with no intervention or adjustment by the user being required, and preferably with the user not noticing the adaptation of the equipment to its service area).” Column 5, lines 2-11. Applicants respectfully submit that the fundamental object of the Rostoker et al. invention is to provide this self-adaptation between certain frequencies or protocol standards and that it is clearly an object of the invention and preferable that the user not notice the adaptation and that such change is transparent to the user. Rostoker et al. continue throughout their detailed description of their invention to introduce the appropriate circuitry that performs the transparent self-adaptation operation.

In contrast to the objects of Rostoker et al. are the teachings of Dahm et al. Their teachings relate to a visual interface to mobile subscriber account services. As is noted in the Abstract, Dahm et al. focus on a visual interface for a mobile device in which a subscriber can interact with account services that are suitable for the mobile device and that have a small screen. The Field of the Invention is introduced in Dahm et al. as relating to user interfaces to mobile subscriber account services that includes such features such as billing, customer service requests and so forth whereas visual interfaces to the mobile subscriber account services are provided through mobile devices which have a small screen and communicate over wireless data

networks. Therefore, it is easily identifiable that the entire focus of Dahm et al. is a small screen user visual interface that provides such user information to the user account in a manner in which the user can interact with the computing device.

Accordingly, Applicants respectfully submit that one of skill in the art would certainly not have *motivation* to combine the transparent self-adaptation method of Rostoker et al. with the visual interface of Dahm et al. These references have been shown to teach away from one another with regards to whether information is visually presented to the user or not. Therefore, these references cannot be combined for this reason.

A further reason that one of skill in the art would not have sufficient motivation or suggestion to combine these references is eluded to above. Where one of skill in the art would recognize that a fundamental principle of operation of one or both of the references would have to be modified or altered in order to accommodate the blending of the these references, then the law establishes that it would not be obvious to combine them. In this case, the object identified by Rostoker et al. in which the self-adaptation of a cell phone to different protocols that is transparent or not noticeable to the user would have to be modified if that feature were to be blended with a visual interface taught in Dahm et al. Applicants respectfully submit that this clearly the case and that if any kind of visual interface associated with account services were to be incorporated into the teachings of Rostoker et al. then by definition the user would have to have some kind of visual information associated with the self-adaptation approach. Because Rostoker et al. frames his entire invention in the context of a need to provide this adaptation in a transparent way to the user, Applicants respectfully submit that this is a fundamental principle of the Rostoker et al. invention and such a feature would have to be modified in order to accommodate the teachings of Dahm et al.

Applicants therefore submit that rather than one of ordinary skill in the art having the motivation to perform such a modification for the purpose of maintaining cost-effective and positive relationships with a mobile user for handling customer requests, rather it becomes clear that the fundamental principles of either of these references would have to be modified in order to blend these references. Wherein the express object of the Rostoker et al. invention is to provide a transparent self-adaptation between communication protocols, certainly one of skill in the art would not be *motivated* to eliminate such transparency and provide a visual interface such that the self-adaptation of converting from one interface to next is actually *not* transparent, such that it *becomes* noticeable to the user. For this basic reason, because there are expressed teachings away from such combination, one of skill in the art would not be motivated to combine these references. Accordingly, Applicants submit that claims 1-5, 7-8, 11-12, 14-19, 21 and 22 are patentable and in condition for allowance.

Rejection of Claims 6, 9, 10, 13, 20, 23 and 24 Under 35 U.S.C. §103(a)

The Office Action rejects claims 6, 9, 10, 13, 20, 23 and 24 under 35 U.S.C. §103(a) as being unpatentable over Rostoker et al. in view of Dahm et al. in further view of Stewart et al. (U.S. Patent No. 6,732,176) ("Stewart et al."). Applicants respectfully traverse this rejection and submit that because the primary references of Rostoker et al. and Dahm et al. cannot be legally combined in that they actually teach away from such combination, Applicants respectfully submit that claims 5, 9, 10, 13, 20, 23 and 24 are patentable and in condition for allowance.

CONCLUSION

Having addressed all rejections and objections, Applicants respectfully submit that the subject application is in condition for allowance and a Notice to that effect is earnestly solicited. If necessary, the Commissioner for Patents is authorized to charge or credit the **Deposit Account No. 50-3102** for any deficiency or overpayment.

Respectfully submitted,

Date: February 21, 2007

By: 

Correspondence Address:
Customer No. 49637

Thomas M. Isaacson
Attorney for Applicants
Reg. No. 44,166
Phone: 410-286-9405
Fax No.: 410-510-1433